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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,046	04/21/2005	Hiromune Ozaki	SAEG173.001APC	3156
20995	7590	10/24/2007		
KNOBBE MARTENS OLSON & BEAR LLP			EXAMINER	
2040 MAIN STREET			NICKERSON, JEFFREY L	
FOURTEENTH FLOOR				
IRVINE, CA 92614			ART UNIT	PAPER NUMBER
			4117	
			NOTIFICATION DATE	DELIVERY MODE
			10/24/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/509,046

Applicant(s)

OZAKI, HIROMUNE

Examiner

Jeffrey Nickerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 21 January 2005.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to Application No. 10/509,046 filed on 21 April 2005. Claims 1-8 have been examined.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Method and server for managing and enrolling e-mail subscribers.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because it exceeds 150 words. Correction is required. See MPEP § 608.01(b).

Claim Objections

5. Claim 8 is objected to because of the following informalities: dependent claim uses a different class of invention.

Regarding claim 8, this claim depends on a parent claim that has a different class of invention. The preamble of this dependent claim makes claim to a program when the parent independent claim makes claim to a method. Dependent claim chains should be consistent in the category of subject matter being claimed. The examiner requests that claim 8 be revised to either be a method claim that further limits the method of claim 1 or be changed to an independent claim of a different class that includes all limitations of claim 1. For example, claim 8 could read, "A computer readable storage medium that contains instructions to perform the following: ..."

Appropriate correction is required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 8, computer-related inventions whether descriptive or functionally descriptive material are non-statutory categories when claimed as descriptive material *per se* (see *Warmerdam*, 33 F.3d at 1360 USPQ2d at 1759), falling under the “process” category (i.e. inventions that consist of a series of steps or acts to be performed). See 35 U.S.C. 100(b) (“The term process means, art, or method, and includes a new or improved process, machine, manufacture, composition of matter or material”). Functional descriptive material: “data structures” representing descriptive material *per se* or computer program representing computer listing *per se* (i.e. software *per se*) when embodied in a computer-readable media are still not statutory because they are not capable of causing functional change in the computer. However, a claimed computer-readable *storage* medium encoded with a data structure, computer listing or computer program, having defined structural and functional interrelationships between the data structure, computer listing or computer program and the computer software and

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hardware component, which permit the data structure's, listing or program's functionality to be realized, is statutory (see MPEP §2106).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 2, and 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Druckenmiller et al (US 6,167,435), and further in view of Ferber (US 7,184,971 B1).

Regarding claim 1, Druckenmiller teaches a method for distributing information (informational messages) to multiple users via a network (Druckenmiller: col 2, lines 58-65 specify multiple subscribers connected to the distribution server over a network), the method comprising the steps of:

transmitting notice information (emails, messages, specifically verification emails) to a destination email address of a registered user (subscriber) whose user information, including a unique user ID (unique token) and the destination email address, has been stored, the notice information containing the user ID; (Druckenmiller: col 4, lines 30-56

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specify that the subscribers register for mailing lists which are distributed to their email address via email notices; Druckenmiller: col 4, line 58 – col 5, line 11 specify associating a token with the subscriber and their email address and storing the user information in a database; This section also specifies sending a verification email containing the user token)

acquiring the user ID of the registered user and transmitting a designated Web page when the registered user clicks a banner area (link) that is displayed on the user terminal by receiving the notice information (Druckenmiller: col 5, lines 16-33 specify that one embodiment involves returning the token by clicking a URL and filling a form, which implies sending a web page to the user terminal; See also Figure 3, items 38, 32, 34);

transmitting the notice information to the email address of a registered user that is specified when a request for sending the notice information is made by the user via the Web page, the notice information containing the user ID; (Druckenmiller: col 4, lines 30-67 specify signing up for subscriptions on a web page and being sent a verification email containing a unique token)

Druckenmiller does not teach wherein a registered user makes the request and the notice information is forwarded to an unregistered user. Nor does he teach where he acquires the user ID of the registered user from the unregistered user. Nor does he teach further issuing and storing the unregistered user an ID that is associated with the referring user ID when the unregistered user makes a registration request.

Ferber, in a similar field of endeavor, teaches a system wherein subscribers can refer unregistered users to be sent notice information (Ferber: Figure 2, item 230; Ferber: col 12, lines 38-64 specify subscribers referring unregistered users using their software means; col 2, lines 5-24 specify the software is email based and referrals are tracked; col 3, lines 1-4 further specify that the email referrals are kept track of). He further teaches acquiring the user ID of the registered user from the unregistered user (Ferber: col 12, lines 28-38 specify a registering user indicates the referring user). He further teaches issuing and storing the unregistered user an ID that is associated with the referring user ID when the unregistered user makes a registration request (Ferber: col 12, lines 28-64 specify the user referral information is stored, keeping track of referrers; Ferber: col 3, lines 1-4 also specify the information stored, implying they are associated).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Ferber for using subscriber referrals in the email distribution system. The teachings of Ferber, when implemented in Druckenmiller's system, will enable one of ordinary skill in the art to offer incentives for subscriber referrals and increase the advertisement distribution database. One of ordinary skill in the art would be motivated to utilize the teachings of Ferber in the Druckenmiller system in order to "offer incentives to accumulate subscribers or email addresses and get subscribers to view advertisements" (Ferber: col 1, lines 40-45).

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Regarding claim 2, the Druckenmiller/Ferber system teaches wherein the notice information transmitted by the server to the registered or unregistered user contains information indicating the location of the Web page and being accompanied by the user ID (Druckenmiller: Figure 3, item 38 depicts the URL which is a location of a Web page; Figure 3, item 32 depicts the user's email address which is used as an identifier; Figure 3, item 34 depicts the user's token ID, another user ID).

Regarding claim 4, the Druckenmiller/Ferber system teaches wherein the notice information transmitted by the server to the addresses selected from multiple forwarding addresses (mail lists, distribution lists) specified by the registered user (Ferber: col 2, lines 19-24 specify that the messages can be sent to distribution lists) lists eliminating those stored as ones to which notice information cannot be sent. (Ferber: col 3, lines 36-36 specify the system removes undeliverable email addresses)

Regarding claim 5, the Druckenmiller/Ferber system teaches wherein the email addresses to which notice information cannot be sent include the email addresses of unregistered users who have sent a notice to the effect that they do not wish to receive the notice information. (Druckenmiller: col 7 line 55 – col 8, line 8 specify how users can unsubscribe from a mailing list)

Regarding claim 6, the Druckenmiller/Ferber system teaches wherein the notice information is transmitted via email. (Druckenmiller: col 9, lines 49-56 specify the

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various mediums this invention can occur on, including the preferred embodiment of email)

Regarding claim 7, this server claim comprises limitations substantially similar to that of claim 1 and the same rationale of rejection is used, where applicable.

Regarding claim 8, this program claim comprises limitations substantially similar to that of claim 1 and the same rationale of rejection is used, where applicable.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Druckenmiller et al (US 6,167,435) and Ferber (US 7,184,971 B1), and further in view of Harvey et al (US 6,487,583 B1).

Regarding claim 3, the Druckenmiller/Ferber system teaches referring users to subscribe to mail lists.

The Druckenmiller/Ferber system does not teach wherein the referrer can forward comments to the unregistered user.

Harvey, in a similar field of endeavor, teaches wherein notice information (invitation) transmitted by the server to the forwarding address includes comment data received from the registered user. (Harvey: col 13, line 58 – col 14, line 6 specifies the

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inviting user can add personalized information such as comments to an invitation request, which is a message sent to an unregistered user.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Harvey for having personalizing invitation requests. The teachings of Harvey, when implemented in the Druckenmiller/Ferber system, would allow for the customization of verification and invitation messages. One of ordinary skill in the art would be motivated to utilize the teachings of Harvey in the Druckenmiller/Ferber system in order to "describe various aspects, ... including general portions of interest to the invited users." (Harvey: col 14, lines 3-6)

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Aggarwal et al (US 6,714,975 B1) discloses a method for advertising using a self-learning algorithm on user preferences.
- b. Frolik et al (US 7,149,783 B2) discloses a system for distributing electronic publications with an emphasis of only allowing subscribers to access the publications in sequential order.
- c. Herz (US 6,460,036 B1) discloses a system and method for customizing electronic advertisements to be inserted in electronic newspapers, based off target profiles created from the content in the electronic newspapers.

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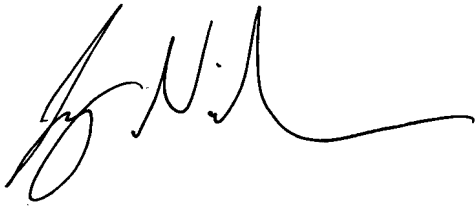
- d. Knapp et al (US 6,769,010 B1) discloses a system and apparatus for distributing content over the network based on receiving user identifiers, including the ability to insert advertisements into the content.
- e. Langseth et al (US 6,694,316 B1) discloses a system and method for managing channel based distribution subscriptions.
- f. Roemke et al (US 7,054,869 B1) discloses a system and method for managing subscription based content distribution using global versus local administrators.
- g. Weinreich et al (US 6,175,831 B1) discloses a method and apparatus for managing user relationships by constructing a database based on email messaging.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Nickerson whose telephone number is 571-270-3631. The examiner can normally be reached on M-Th, 8:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beatriz Prieto can be reached on 571-272-3902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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October 15, 2007



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